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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Clark H. Gates, II
Serial No.: 10/008,738
Filed: 11/09/2001
For: Electrical Box with Recessed Faceplate
Confirmation No.: 6062
Group Art Unit: 3727
Examiner: Joseph C. Merek
Attorney Docket No.: PGATEC-EB

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Express Mail Label No. ED789765505US

Date of Deposit: June 1, 2005

I hereby certify that the following attached

Transmittal of Appeal Brief

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Thompson E. Fehr
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TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION-37 CFR 41.37)

1. Transmitted herewith is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed in this case on February 26, 2004, and pursuant to the Examiner's Notification of Non-Compliance with 37 CFR 1.192(c), which was mailed on December 1, 2004.

2. STATUS OF APPLICANT

This application is on behalf of a small entity.

The statement of small entity status has already been filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 CFR 41.20(b)(2) the fee for filing the Appeal Brief is \$250.00. This fee was paid with the initial filing of the Appeal Brief on August 25, 2004.

4. EXTENSION OF TERM

The proceedings herein are for a patent application, and the provisions of 37 CFR 1.136 apply.

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Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)(1)-(5)) for a total of five months. The requisite fee for a small entity is \$1,080.00.

Fee \$1,080.00

5. TOTAL FEE DUE

The total fee due is

Extension fee	\$1,080.00
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TOTAL FEE DUE	\$1,080.00
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6. Attached is a check in the sum of \$1,080.00.

7. In accordance with the Examiner's indicating that the Grouping of Claims was unclear, the paragraph explaining the difference between claims 15 and 17 has been moved from the Grouping of Claims to the end of the Summary of Invention.

8. Because the Examiner has objected to the presentation of PCT application no. PCTUS/2002/035791 and the Search Report for that PCT application, they have been removed; and the Board is requested to take judicial notice of them.

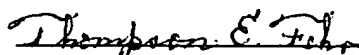
PCT application no. PCTUS/2002/035791 is virtually identical to the original Application in the present case. Such PCT application has been published by the World Intellectual Property Organization as International Publication No. WO 03/043139 A2; the International Search Report for such PCT application has been published by the World Intellectual Property Organization as International Publication No. WO 2003/043139 A3.

Having been published by World Intellectual Property Office and made available on the web site of the European Patent Office, the PCT Application and the Search Report identified above as well as the fact that the examiner in the European Patent Office found no lack of clarity and even found the claims to be patentable in PCT application no. PCTUS/2002/035791, which is virtually identical to the original Application in the present case, meet the test for adjudicative facts of which judicial notice is appropriately taken, *i.e.*, what constitutes the PCT Application and the Search Report as well as the finding by the European patent Examiner are capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.

As will be evident once judicial notice is taken of the Search Report, it was published after the final rejection was issued in this case; so, there was no opportunity to present it and the conclusions of the European patent examiner to the Examiner dealing with the present United States domestic patent application.

The finding by the European patent examiner constitutes compelling evidence, the disregard of which, Appellant respectfully submits, would create serious questions regarding due process and fundamental fairness. This evidence is, thus necessary and could not have been presented earlier, thereby complying with the requirements of 37 CFR § 41.33.

DATED this 1st day of June, 2005.

A handwritten signature in cursive script, reading "Thompson E. Fehr", is written over a horizontal line.

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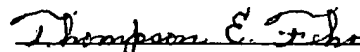
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Date of Deposit: June 1, 2005

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Appellant's Brief

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APPELLANT'S BRIEF (37 CFR 1.192)

This brief is in furtherance of the Notice of Appeal filed in this case on February 26, 2004, and pursuant to the Examiner's Notification of Non-Compliance with 37 CFR 1.192(c), which was mailed on December 1, 2004.

The fees required under § 41.20 and any required petition for extension of time for filing this brief and fees therefor are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains the following items, under headings of the same name and in the order given:

REAL PARTY IN INTEREST
RELATED APPEALS AND INTERFERENCES
STATUS OF CLAIMS
STATUS OF AMENDMENTS
SUMMARY OF INVENTION
ISSUES
GROUPING OF CLAIMS
ARGUMENT
 Rejections under 35 U.S.C. 103
APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

The final page of this brief bears the attorney's signature.

REAL PARTY IN INTEREST

The real party in interest is Clark H. Gates, II.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants or Appellants' legal representative which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1 through 28 were in the original Application; subject to a requirement for restriction, claims 1 through 12, 16, 18, 22, 24 through 28 were withdrawn, leaving claims 13 through 15, 17, 19 through 21, and 23 pending.

The claims being appealed are claims 13 through 15, 17, 19 through 21, and 23.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the final rejection.

SUMMARY OF INVENTION

A basic summary of the invention is given on page 6 of the present application:

The present invention includes . . . a new electrical box with a recessed faceplate

. . . [The new electrical box has] a one-piece faceplate; but the new electrical box is also designed to accommodate a two-part faceplate which permits adjusting the distance between the outward surface of the electrical instrumentality installed within the electrical box and the flange at the front of the faceplate so that, after installation of the box, it can be assured that the flange of the faceplate will be flush against the wall in which the electrical box has been installed and that a wall of the faceplate will be flush against the outward surface of the installed electrical equipment, thereby meeting, in a relatively easy fashion, the . . . National Electrical Code.

Furthermore, no screws or other components of a releasable fastener not employing screws are exposed in any of the versions of the electrical box; and once the electrical instrumentality is installed within the box, there are no openings in the electrical box.

The preceding is basically accomplished by enlarging both the height and width of the mouth of the electrical box as well as adding threaded channels to the sides of the electrical box.

Greater understanding of the invention can be obtained from page 8, line 1 through page 10, line 27 and page 11, line 13 through page 11, line 27:

The Electrical Box with Recessed Faceplate having a one-piece recessed faceplate but designed to accommodate a two-piece recessed faceplate has, as illustrated in Figure 1, a box 1 into which a one-piece recessed faceplate 2 is removably inserted.

The box 1 has an open front or mouth 3 and a closed back 4, although the rear wall 4 contains the knock-out tabs that are well known in the art for creating openings through which wiring can pass.

Attached to and projecting generally forward from the rear wall 4 is a lateral surface 1500 that connects the perimeter 1501 of the rear wall 4 to a first end 1502 of a connecting wall 1503 which connecting wall 1503 extends generally outward from, and preferably, perpendicular to, the lateral surface 1500. Attached to and projecting generally forward from the second end 1504 and from the sides 1505 of the connecting wall 1503 is the first end 1506 of the front portion 11. The second end 1507 of the front portion 11 forms the mouth 3 of the box 1.

The top 5, bottom 6, and sides 7 of the rear portion 8 of the box 1 each contain a channel 9 extending into the box 1 to accommodate a releasable fastener, preferably a screw, 10, with each channel 9 extending toward the back 4 of the box 1 and preferably being generally centrally located across the top 5, bottom 6, and each side 7 of the box 1.

In the preferred embodiment, the box 1 has a rectangular cross section. As illustrated in Figure 1 and Figure 2, the front portion 11 of the box 1 extends beyond the top 5 and beyond the bottom 6 of the rear portion 8. A top wall 12 that is preferably generally parallel to the front 3 and the back 4 of the box 1 runs from the top 5 of the rear portion 8 to the top 13 of the front portion 11 of the box 1 and between the sides 7 of the box 1. Similarly, a bottom wall 16 that is preferably generally parallel to the front 3 and the back 4 of the box 1 runs from the bottom 6 of the rear portion 8 to the bottom 17 of the front portion 11 of the

box 1 and between the sides 7 of the box 1. Thus, in the preferred embodiment, the connecting wall 1503 is comprised of the top wall 12 and the bottom wall 16 and sides 7 which are integrally formed with the sides 7 of the rear portion 8 and the sides 7 of the front portion 11 of the box 1.

As suggested above, the interior ends 1001 of the channels 9 lie within the front portion 11 of the box 1; such ends 1001 are preferably covered except for a threaded aperture 1002 in such ends 1001 and are preferably all substantially aligned with one another.

The channels 9 and, in the preferred embodiment, the threaded apertures 1002 of the upper and lower channels 9 are used either to attach an electrical instrumentality 15 or a faceplate to the box 1. Whether the attachment is for an electrical instrumentality 15 or a faceplate is determined by whether the electrical instrumentality 15 is intended to be attached to the faceplate or directly to the box 1. This is the same situation as for traditional electrical boxes. If the electrical instrumentality 15 is intended to be attached directly to the box 1, the threaded apertures 1002 of the upper and lower channels 9 each accommodate a screw 10 for holding the electrical instrumentality 15 to the box 1, as illustrated in Figure 1 through Figure 4. Otherwise, the threaded apertures 1002 of the upper and lower channels 9 would be available to retain a screw 10 for holding the faceplate to the box 1.

Furthermore, as is the case with traditional faceplates, attachment of an electrical instrumentality 15 to a faceplate can be permanent or releasable, at least when the faceplate is intended to be attached directly to the box 1.

Retention of faceplates, whether one-piece or two-piece, to electrical boxes 1 is, as indicated above, preferably done with screws 10, as illustrated in Figure 1 through Figure 4, since screws tend to pull the faceplate against the mounting surface. However, the only essential feature is that a releasable fastener be used to hold the faceplate either directly to the box 1 or indirectly to the box 1 by having the faceplate directly attached, with a releasable fastener, to an electrical instrumentality 15 that is, itself, directly connected to the box 1 with a releasable fastener. Thus, for example, any type of snap-fit for a faceplate to the box 1 or to the electrical instrumentality 15 that is well known in the art may be employed.

For the embodiments depicted in Figure 1 through Figure 4, the top wall 12 contains an aperture 19 to accommodate a screw 10 that extends through the top wall 12 outside the box 1. Similarly, the bottom wall 16 contains an aperture 20 to accommodate a screw 10 that extends through the bottom wall 16 outside the box 1 for the same purpose as the aperture 19. Apertures 19, 20 accommodate screws 10 which are used to attach faceplates to the type of electrical instrumentality 15 depicted in Figure 1 through Figure 4, using threaded aperture

101 of the electrical instrumentality **15**. For different electrical instrumentalities, however, the number and location of apertures for attaching a faceplate to an electrical instrumentality **15** depend upon particular electrical instrumentality **15** that is utilized.

The channels **9** on the sides **7** of the box **1** and their associated threaded apertures **1002** accommodate screws **10** to draw toward the box **1** and retain the outer portion **24** of a two-piece recessed faceplate **25**, as shown in Figure 3.

The one-piece recessed faceplate **2** has a rear wall **26** containing one or more instrumentality apertures **27** to accommodate the electrical instrumentality **15**. Attached to and projecting generally forward from the rear wall **26** is an interior surface **1400** that connects the perimeter **1401** of the rear wall **26** to a flange **33**. The rear wall **26** has substantially the same shape as does the cross section of the front portion **11** of the box **1**. In the case of a box **1** having a traditionally rectangular cross section, as depicted in Figure 1 and Figure 2, the interior surface **1400** comprises a top **27**, bottom **28**, and two sides **29** attached to one another so as to form a four-sided object. To the front **30** of the top **27**, the front **31** of the bottom **28**, and the front **32** of the two sides **29** is attached a flange **33**, the back side **34** of which flange **33** is designed to seat against the mounting surface. The faceplate **2** has, in comparison to the box **1**, dimensions such that the flange **33** extends from the interior surface **1400** of the box **1** to a position laterally beyond the front of the mouth **3**.

The rear wall **26** is also adapted to accommodate a releasable fastener for fastening the faceplate **2** directly or indirectly, through the electrical instrumentality **15**, to the box **1**. Preferably, this consists of one or more apertures **1003** to accommodate screws **10**.

Thus, the Electrical Box with Recessed Faceplate having a one-piece recessed faceplate has a box **1** adapted to accommodate a two-piece recessed faceplate **25**, has no screws **10** or analogous components of another type of releasable fastener exposed within the box **1** behind the installed electrical equipment **15**, and possesses no substantial gaps or apertures other than those designed to accommodate the installed electrical equipment **15** and screws **10** or components of another type of releasable fastener. The description to this point has concentrated upon the embodiments depicted in Figure 1 through Figure 4. Any embodiment utilizing the inventive features described in the first sentence of this paragraph would, however, fall within the scope of this invention, *e.g.*, the cross section of the box **1** need not necessarily be rectangular.

...

The outer portion **24** of the two-piece recessed faceplate **25** is constructed just as is the one-piece recessed faceplate **2** except that such outer portion **24** does not have a rear wall **26** but instead has attached to each side **29** a longitudinal

projection **201** extending inward having an aperture **44** to accommodate a screw **10** or other releasable fastener that will draw toward the box **1**, and retain, the outer portion **24** of the two-piece recessed faceplate **25**. This pulls the back side **34** of the flange **33** against the mounting surface.

The inner portion **45** of the two-piece recessed faceplate **25** is constructed the same as the one-piece recessed faceplate **2** except that it does not have the flange **33** but does possess the number of apertures **46**, two apertures **46** in the case of screws **10**, to accommodate the releasable fasteners that draw the outer portion **24** of the two-piece recessed faceplate **25** to the box **1**.

The top **27**, bottom **28**, and two sides **29** for the outer portion **24** of the two-piece recessed faceplate **25** are sized so that they will slide along the inside of the top **27**, bottom **28**, and two sides **29**, respectively, of the inner portion **45** in order that there will substantially be no gaps between these corresponding features.

Claims 15 and 17 depend upon claim 13, and claims 21 and 23 depend upon claim 19.

The difference between claim 13 and claim 19 is simply that in claim 19 accommodation is made for a fastener to attach the faceplate directly to the box whereas in claim 13 accommodation is made for releasable fasteners indirectly to attach the faceplate to the box, through the electrical instrumentality. (In each claim accommodation is made for a fastener to attach the electrical instrumentality to the faceplate.)

ISSUES

There are two issues in this appeal.

The first issue is whether or not claims 13 through 15, 17, 19 through 21, and 23 contain subject matter which was described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention (35 U.S.C. § 112, first paragraph).

The second issue is whether or not claims 13 through 15, 17, 19 through 21, and 23 particularly point out and distinctly claim the subject matter which applicant regards as his invention (35 U.S.C. § 112, second paragraph).

GROUPING OF CLAIMS

Appellant does not contend that, for each ground of rejection being contested, the claims of the group do not stand or fall together.

ARGUMENT

Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner has stated:

Claims 13-15, 17, 19-21, and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 13 and 19, the claims set forth a connecting wall. However, the drawings show to [*sic*] separate connecting walls one on each side of the rear wall. The claims state that the connecting wall has a first end that is attached to the lateral surface and projects generally outward from the lateral surface. The second connecting wall is not specified. The claim does not set forth to what part of the lateral surface is attached. The claim sets for that a front portion is attached and projecting generally forward from the sides and the second end of the connecting wall. It is not clear how the front portion is connected to only the one connecting wall. Moreover, the first end of the front portion only requires three sides connected to the connecting wall. It is not clear how the front portion is attached to the connecting wall on three surfaces. The remaining claims are included since they stem from the rejected claims. . . .

Appellant respectfully asserts that the Examiner, in saying that the drawings show two separate connecting walls, has made an error that one of ordinary skill in the art would not make.

Lines 7 through 26 on page 8 of the Application describe the connecting wall:

Attached to and projecting generally forward from the rear wall **4** is a lateral surface **1500** that connects the perimeter **1501** of the rear wall **4** to a first end **1502** of a connecting wall **1503** which connecting wall **1503** extends generally outward from, and preferably, perpendicular to, the lateral surface **1500**. Attached to and projecting generally forward from the second end **1504** and from the sides **1505** of the connecting wall **1503** is the first end **1506** of the front portion **11**. The second end **1507** of the front portion **11** forms the mouth **3** of the box **1**.

The top **5**, bottom **6**, and sides **7** of the rear portion **8** of the box **1** each contain a channel **9** extending into the box **1** to accommodate a releasable fastener, preferably a screw, **10**, with each channel **9** extending toward the back **4** of the box **1** and preferably being generally centrally located across the top **5**, bottom **6**, and each side **7** of the box **1**.

In the preferred embodiment, the box **1** has a rectangular cross section. As illustrated in Figure 1 and Figure 2, the front portion **11** of the box **1** extends beyond the top **5** and beyond the bottom **6** of the rear portion **8**. A top wall **12** that is preferably generally parallel to the front **3** and the back **4** of the box **1** runs from the top **5** of the rear portion **8** to the top **13** of the front portion **11** of the box **1** and between the sides **7** of the box **1**. Similarly, a bottom wall **16** that is preferably generally parallel to the front **3** and the back **4** of the box **1** runs from the bottom **6** of the rear portion **8** to the bottom **17** of the front portion **11** of the box **1** and between the sides **7** of the box **1**. Thus, in the preferred embodiment, the connecting wall **1503** is comprised of the top wall **12** and the bottom wall **16** and sides **7** which are integrally formed with the sides **7** of the rear portion **8** and the sides **7** of the front portion **11** of the box **1**.

Hence, there is only one connecting wall **1503**, even though it includes a top wall **12** and a bottom wall **16**. (It may be a slight error that is rectifiable without introducing new matter, to have, in the last paragraph of the immediately preceding quotation, referred to sides **7** of the connecting wall **1503**, instead of sides **1505** of the connecting wall **1503**, although Appellant believes this was correct since the sides of the connecting wall are identified as **1505** when the connecting wall is being considered alone and are identified as **7** when they are considered as an integral part of the entire side of the box **1**, encompassing the rear portion, the connecting wall, and the front portion of the box **1**.) All of the features are shown in Figure 3. And, in an attempt to clarify this situation for the Examiner beyond what Appellant respectfully believes

would be required for one of ordinary skill in the art, Appellant amended the specification, amended claims 13 and 19, and added Figure 7.

The amendment to the specification was as follows:

Attached to and projecting generally forward from the rear wall 4 is a lateral surface 1500 that connects the perimeter 1501 of the rear wall 4 to a first end 1502 of a connecting wall 1503 which connecting wall 1503 extends generally outward from, and preferably, perpendicular to, the lateral surface 1500. A first end 4050 of the lateral surface 1500 is connected to the perimeter 1501 of the rear wall 4, and a second end 4060 of the lateral surface 1500 is connected to the first end 1502 of the connecting wall 1503. Attached to and projecting generally forward from the second end 1504 and from the sides 1505 (At least when the box 1 has a rectangular shape, the portions of the second end 1504 of the connecting wall 1503 that is in the same plane as the sides 7 of the box 1 are termed "sides" 1505.) of the connecting wall 1503 is the first end 1506 of the front portion 11. The second end 1507 of the front portion 11 forms the mouth 3 of the box 1.

Similarly, claims 13 and 19 were amended as follows:

Claim 13 (currently amended): An Electrical Box with Recessed Faceplate, which comprises:

a faceplate comprising:

an outer portion comprising:

a flange;

an interior surface having sides, being attached to the flange, and projecting generally rearward from the flange; and

a longitudinal projection extending inward from each side of the interior surface and having a means for accommodating a releasable fastener; and

an inner portion comprising:

a rear wall with a perimeter and a cross-sectional shape, the rear wall containing one or more instrumentality apertures and having a means for accommodating a releasable fastener for attaching said faceplate to an electrical instrumentality as well as a means for accommodating a second releasable fastener; and

an interior surface projecting generally forward from the rear wall and connected to the rear wall, with the dimensions of the interior surface of the inner portion being such that the interior surface of the inner portion will fit into and slide along the interior surface of the outer portion with substantially no gaps between such interior surfaces; and

a box comprising:

a rear wall having a perimeter;

a lateral surface, having a first end attached to and projecting generally forward from the perimeter of the rear wall and having a top containing a channel, a bottom containing a channel, and sides each containing a channel, with each channel having an interior end;

a connecting wall having a first end attached to a second end of the lateral surface, the connecting wall having sides and a second end and said connecting wall extending generally outward from the lateral surface; and

a front portion having a first end attached to and projecting generally forward from the sides and the second end of the connecting wall, the front portion containing the interior ends of the channels, the front portion having a second end forming an open mouth, the front portion having substantially the

same cross-sectional shape as does the rear wall of said faceplate, and the front portion having dimensions such that the flange of the faceplate extends from the interior surface to a position laterally beyond the front of the mouth;

a means for accommodating a releasable fastener for attaching said box to an electrical instrumentality; and

a means for accommodating a releasable fastener for drawing toward said box and releasably retaining the outer portion of said faceplate.

Claim 19 (currently amended): An Electrical Box with Recessed Faceplate, which comprises:

a faceplate comprising:

an outer portion comprising:

a flange;

an interior surface having sides, being attached to the flange, and projecting generally rearward from the flange; and

a longitudinal projection extending inward from each side of the interior surface and having a means for accommodating a releasable fastener; and

an inner portion comprising:

a rear wall with a perimeter and a cross-sectional shape, the rear wall containing one or more instrumentality apertures and having a means for accommodating a fastener for attaching said faceplate to an electrical instrumentality as well as a means for accommodating a releasable fastener; and

an interior surface projecting generally forward from the rear wall and connected to the rear wall, with the dimensions of the interior surface of the inner portion being such that the interior surface of the inner portion will fit into and slide along the interior surface of the outer portion with substantially no gaps between such interior surfaces; and

a box comprising:

a rear wall having a perimeter;

a lateral surface, having a first end attached to and projecting generally forward from the perimeter of the rear wall and having a top containing a channel, a bottom containing a channel, and sides each containing a channel, with each channel having an interior end;

a connecting wall having a first end attached to a second end of the lateral surface, the connecting wall having sides and a second end and said connecting wall extending generally outward from the lateral surface; and

a front portion having a first end attached to and projecting generally forward from the sides and the second end of the connecting wall, the front portion containing the interior ends of the channels, the front portion having a second end forming an open mouth, the front portion having substantially the same cross-sectional shape as does the rear wall of said faceplate, and the front portion having dimensions such that the flange of the faceplate extends from the interior surface to a position laterally beyond the front of the mouth;

a means for accommodating a releasable fastener for attaching said box to said faceplate; and

a means for accommodating a releasable fastener for drawing toward said box and releasably retaining the outer portion of said faceplate.

And Figure 7 is shown in Attachment 1 hereto.

The Examiner has further declared:

. . . Regarding claim 13 and 19, there is no support for the “lateral surface having a first end” or the “connecting wall having a first end attached to a second end of the lateral surface”. The lateral surface was never shown as having ends. Moreover, the lateral surface having first and second ends does not make sense in light of the original drawings, claims, and disclosure. This is a new matter rejection. The remaining claims are included since they stem from rejected claims.

As noted above, lines 7 through 26 on page 8 of the Application describe the lateral surface:

Attached to and projecting generally forward from the rear wall **4** is a lateral surface **1500** that connects the perimeter **1501** of the rear wall **4** to a first end **1502** of a connecting wall **1503** which connecting wall **1503** extends generally outward from, and preferably, perpendicular to, the lateral surface **1500**. Attached to and projecting generally forward from the second end **1504** and from the sides **1505** of the connecting wall **1503** is the first end **1506** of the front portion **11**. The second end **1507** of the front portion **11** forms the mouth **3** of the box **1**.

Furthermore, the lateral surface **1500** is depicted in Figures 1 through 4. It is obvious both from the language quoted immediately above and Figures 1 through 4 that the lateral surface **1500** connects the rear wall **4** to a first end **1502** of a connecting wall **1503**. And it is apparent from Figures 1 through 4 that one extremity of the lateral surface **1500** is attached to the perimeter **1501** of the rear wall **4** while an opposite extremity of the lateral surface **1500** is connected to a first end **1502** of a connecting wall **1503**. Although the specification did not originally term the one extremity a “first end” and the opposite extremity a “second end,” it would be logical to do so since the open portions of an otherwise closed surface such as the

lateral surface **1500** are generally called “ends.” To add this logical nomenclature is, Appellant respectfully suggest, not tantamount to the introduction of new matter.

The preceding furthermore addresses the Examiner’s objection to the specification, which states, “The added material which is not supported by the original disclosure is as follows: There is no support for the ‘a second end of the lateral surface is connected to a first end of the connecting wall’ or ‘at least when the box has a rectangular shape’”. And the quotation above from lines 7 through 26 on page 8 of the Application shows that the disclosure has always indicated that, in the preferred embodiment, the box **1** has a rectangular cross section.

Notably, the Examiner comments, “The only way the original disclosure make sense are to view the connecting wall as now shown by applicant.” Certainly, one expects a person of ordinary skill in the field to interpret a disclosure in the only way it makes sense. Therefore, to one of ordinary skill in the field, the connecting wall is as it is shown in Figure 7—a fact which precludes violation of any paragraph in 35 U.S.C. § 112.

The Examiner continues, “The second change to the specification implies that the connecting wall may not be in the same plane for other shapes. There is no support for the connecting wall being out of the plane of the lateral surface.”

The language in question is “At least when the box **1** has a rectangular shape, the portions of the second end **1504** of the connecting wall **1503** that is in the same plane as the sides **7** of the box **1** are termed ‘sides’ **1505**.” This defines the term “sides” for use in the Application, especially in the claims. Again in the preceding quotation from lines 7 through 26 on page 8 of the Application, one reads, “. . . a connecting wall **1503** which connecting wall **1503** extends generally outward from, and preferably, perpendicular to, the lateral surface **1500**.” Although portions of the second end **1504** of the connecting wall **1503** may be in the same plane as the

sides 7 of the box 1, the overall connecting wall 1503 is not in the same plane as the lateral surface 1500.

In disapproving the proposed drawing correction filed on June 11, 2003, the Examiner has stated:

. . . The original disclosure does not support the showing of the connecting wall which was disclosed as including the wall segments . . . [1505] on either side of the box included the thin wall structure between the two sections or segments as seen in Proposed Fig. 7. It is clear that the box has this structure in the sidewalls. However, it is not clear that applicant had intended to show the connecting wall to include the thin sections 1502 as seen in proposed Fig. 7.

That the original disclosure does, indeed, provide such support is, Appellant respectfully believes, evident from lines 24 through 26 on page 8 of the Application:

. . . Thus, in the preferred embodiment, the connecting wall 1503 is comprised of the top wall 12 and the bottom wall 16 and sides 7 which are integrally formed with the sides 7 of the rear portion 8 and the sides 7 of the front portion 11 of the box 1.

Applicant respectfully suggests that the foregoing demonstrates that the claims in question meet the requirements of 35 U.S.C. § 112, first paragraph.

Applicant also believes that further evidence for this fact arises from the fact that the examiner in the European Patent Office found no lack of clarity and even found the claims to be patentable in PCT application no. PCTUS/2002/035791, which is virtually identical to the original Application in the present case. Such PCT application has been published by the World Intellectual Property Organization as International Publication No. WO 03/043139 A2; the International Search Report for such PCT application has been published by the World Intellectual Property Organization as International Publication No. WO 2003/043139 A3.

A copy of the PCT application had been included herewith as Attachment 2; a copy of the International Search Report, as Attachment 3. Without providing any citation, the Examiner has

required Appellant to remove these two attachments, claiming that they are evidence that the Examiner had not had the opportunity to review prior to appeal.

Appellant, therefore, requests the Board to take judicial notice of these two documents and the fact that the European patent examiner found no lack of clarity and even found the claims to be patentable. If the Board directs, Appellant will provide new copies of these documents. They can also, of course, be found on the web site of the European Patent Office (<http://ep.espacenet.com>).

Although 37 CFR § 1.152 only explicitly makes the Federal Rules of Evidence applicable to contested cases, a review by Appellant of Board decisions on Westlaw demonstrates that the Board takes judicial notice in appeals.

Rule 201 in the Federal Rules of Evidence provides as follows:

Rule 201. Judicial Notice of Adjudicative Facts

(a) Scope of rule.

This rule governs only judicial notice of adjudicative facts.

(b) Kinds of facts.

A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.

(c) When discretionary.

A court may take judicial notice, whether requested or not.

(d) When mandatory.

A court shall take judicial notice if requested by a party and supplied with the necessary information.

(e) Opportunity to be heard.

A party is entitled upon timely request to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken.

(f) Time of taking notice.

Judicial notice may be taken at any stage of the proceeding.

(g) Instructing jury.

In a civil action or proceeding, the court shall instruct the jury to accept as conclusive any fact judicially noticed. In a criminal case, the court shall instruct the jury that it may, but is not required to, accept as conclusive any fact judicially noticed.

Having been published by World Intellectual Property Office and made available on the web site of the European Patent Office, the PCT Application and the Search Report identified above as well as the fact that the examiner in the European Patent Office found no lack of clarity and even found the claims to be patentable in PCT application no. PCTUS/2002/035791, which is virtually identical to the original Application in the present case, meet the test for adjudicative facts of which judicial notice is appropriately taken, *i.e.*, what constitutes the PCT Application and the Search Report as well as the finding by the European patent Examiner are capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.

As will be evident once judicial notice is taken of the Search Report, it was published after the final rejection was issued in this case; so, there was no opportunity to present it and the conclusions of the European patent examiner to the Examiner dealing with the present United States domestic patent application.

The finding by the European patent examiner constitutes compelling evidence, the disregard of which, Appellant respectfully submits, would create serious questions regarding due process and fundamental fairness. This evidence is, thus necessary and could not have been presented earlier, thereby complying with the requirements of 37 CFR § 41.33.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner's rejections under 35 U.S.C. § 112, second paragraph are identical to his rejections under 35 U.S.C. § 112 and have, consequently, been addressed above.

Appellant respectfully requests that the Board reverse the decision of the Examiner and rule that claims 13 through 15, 17, 19 through 21, and 23 comply with the requirements of both the first and second paragraphs in 35 U.S.C. § 112.

APPENDIX
OF
CLAIMS INVOLVED IN THE APPEAL

The claims are as follows:

1 Claim 13 (currently amended): An Electrical Box with Recessed Faceplate, which
2 comprises:

3 a faceplate comprising:

4 an outer portion comprising:

5 a flange;

6 an interior surface having sides, being attached to the flange, and
7 projecting generally rearward from the flange; and

8 a longitudinal projection extending inward from each side of the
9 interior surface and having a means for accommodating a releasable
10 fastener; and

11 an inner portion comprising:

12 a rear wall with a perimeter and a cross-sectional shape, the rear
13 wall containing one or more instrumentality apertures and having a means
14 for accommodating a releasable fastener for attaching said faceplate to an
15 electrical instrumentality as well as a means for accommodating a second
16 releasable fastener; and

17 an interior surface projecting generally forward from the rear wall
18 and connected to the rear wall, with the dimensions of the interior surface
19 of the inner portion being such that the interior surface of the inner portion
20 will fit into and slide along the interior surface of the outer portion with
21 substantially no gaps between such interior surfaces; and

22 a box comprising:

23 a rear wall having a perimeter;

24 a lateral surface, having a first end attached to and projecting generally
25 forward from the perimeter of the rear wall and having a top containing a channel,

26 a bottom containing a channel, and sides each containing a channel, with each
27 channel having an interior end;

28 a connecting wall having a first end attached to a second end of the lateral
29 surface, the connecting wall having sides and a second end and said connecting
30 wall extending generally outward from the lateral surface; and

31 a front portion having a first end attached to and projecting generally
32 forward from the sides and the second end of the connecting wall, the front
33 portion containing the interior ends of the channels, the front portion having a
34 second end forming an open mouth, the front portion having substantially the
35 same cross-sectional shape as does the rear wall of said faceplate, and the front
36 portion having dimensions such that the flange of the faceplate extends from the
37 interior surface to a position laterally beyond the front of the mouth;

38 a means for accommodating a releasable fastener for attaching said box to
39 an electrical instrumentality; and

40 a means for accommodating a releasable fastener for drawing toward said
41 box and releasably retaining the outer portion of said faceplate.

1 Claim 14 (original): The Electrical Box with Recessed Faceplate as recited in claim 13,
2 wherein:

3 the means for accommodating a releasable fastener in the longitudinal projection
4 is an aperture when the releasable fastener accommodated thereby is a screw;

5 the means for accommodating a releasable fastener for attaching said faceplate to
6 an electrical instrumentality which means comprises part of the faceplate is one or more
7 apertures in the faceplate as well as one or more apertures in the connecting wall when
8 the fastener for attaching said faceplate to an electrical instrumentality is a screw;

9 the means for accommodating a releasable fastener for attaching said box to an
10 electrical instrumentality is a covered interior end having a threaded aperture for the
11 channel on the top of the lateral surface of the box and a covered interior end having a
12 threaded aperture for the channel on the bottom of the lateral surface of the box;

13 the means for accommodating a releasable fastener for drawing toward said box
14 and releasably retaining the outer portion of said faceplate is a covered interior end

15 having a threaded aperture for the channels on the sides of the lateral surface of the box
16 so that said threaded aperture can receive screws which pass through the apertures in the
17 longitudinal projections; and

18 the means for accommodating a second releasable fastener in the rear wall of the
19 faceplate is an aperture.

1 Claim 15 (original): The Electrical Box with Recessed Faceplate as recited in claim 14,
2 wherein:

3 said faceplate and said box each have a rectangular cross section.

1 Claim 17 (original): The Electrical Box with Recessed Faceplate as recited in claim 13,
2 wherein:

3 said faceplate and said box each have a rectangular cross section.

1 Claim 19 (currently amended): An Electrical Box with Recessed Faceplate, which
2 comprises:

3 a faceplate comprising:

4 an outer portion comprising:

5 a flange;

6 an interior surface having sides, being attached to the flange, and
7 projecting generally rearward from the flange; and

8 a longitudinal projection extending inward from each side of the
9 interior surface and having a means for accommodating a releasable
10 fastener; and

11 an inner portion comprising:

12 a rear wall with a perimeter and a cross-sectional shape, the rear
13 wall containing one or more instrumentality apertures and having a means
14 for accommodating a fastener for attaching said faceplate to an electrical
15 instrumentality as well as a means for accommodating a releasable
16 fastener; and

17 an interior surface projecting generally forward from the rear wall
18 and connected to the rear wall, with the dimensions of the interior surface
19 of the inner portion being such that the interior surface of the inner portion

20 will fit into and slide along the interior surface of the outer portion with
21 substantially no gaps between such interior surfaces; and
22 a box comprising:
23 a rear wall having a perimeter;
24 a lateral surface, having a first end attached to and projecting generally
25 forward from the perimeter of the rear wall and having a top containing a channel,
26 a bottom containing a channel, and sides each containing a channel, with each
27 channel having an interior end;
28 a connecting wall having a first end attached to a second end of the lateral
29 surface, the connecting wall having sides and a second end and said connecting
30 wall extending generally outward from the lateral surface; and
31 a front portion having a first end attached to and projecting generally
32 forward from the sides and the second end of the connecting wall, the front
33 portion containing the interior ends of the channels, the front portion having a
34 second end forming an open mouth, the front portion having substantially the
35 same cross-sectional shape as does the rear wall of said faceplate, and the front
36 portion having dimensions such that the flange of the faceplate extends from the
37 interior surface to a position laterally beyond the front of the mouth;
38 a means for accommodating a releasable fastener for attaching said box to
39 said faceplate; and
40 a means for accommodating a releasable fastener for drawing toward said
41 box and releasably retaining the outer portion of said faceplate.

1 Claim 20 (original): The Electrical Box with Recessed Faceplate as recited in claim 19,
2 wherein:

3 the means for accommodating a releasable fastener in the longitudinal projection
4 is an aperture when the releasable fastener accommodated thereby is a screw;

5 the means for accommodating a releasable fastener in the rear wall of the
6 faceplate is one or more apertures in the rear wall of the faceplate when the releasable
7 fastener is a screw; and

8 the means for accommodating a releasable fastener for attaching said box to said
9 faceplate is a covered interior end having a threaded aperture for the channel on the top of
10 the lateral surface of the box and a covered interior end having a threaded aperture for the
11 channel on the bottom of the lateral surface of the box when the releasable fastener is a
12 screw that will pass through the aperture in the rear wall of the faceplate; and

13 the means for accommodating a releasable fastener for drawing toward said box
14 and releasably retaining the outer portion of said faceplate is a covered interior end
15 having a threaded aperture for the channels on the sides of the lateral surface of the box
16 so that said threaded aperture can receive screws which pass through the apertures in the
17 longitudinal projections.

1 Claim 21 (original): The Electrical Box with Recessed Faceplate as recited in claim 20,
2 wherein:

3 said faceplate and said box each have a rectangular cross section.

1 Claim 23 (original): The Electrical Box with Recessed Faceplate as recited in claim 19,
2 wherein:

3 said faceplate and said box each have a rectangular cross section.

Attachment 1

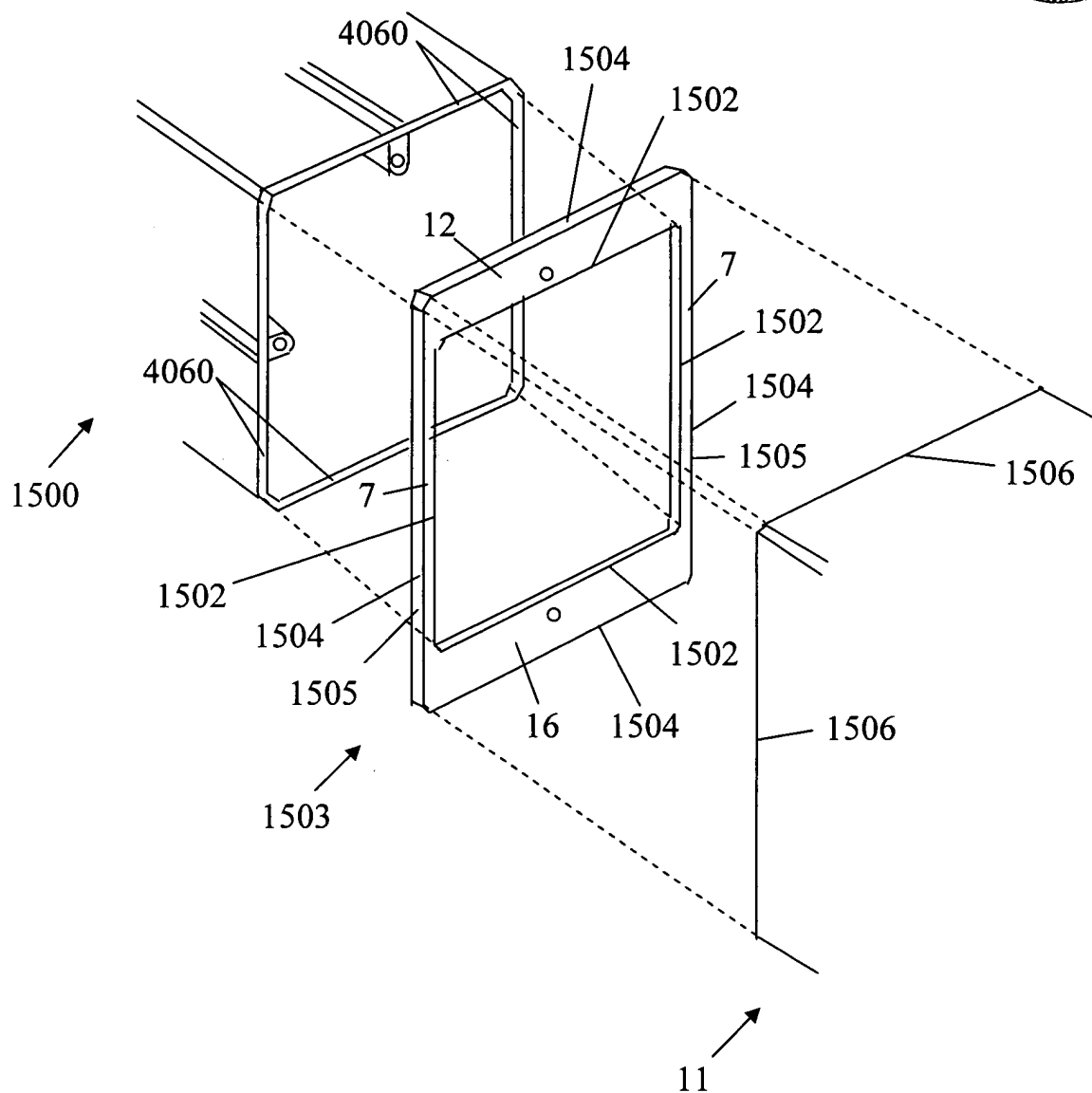
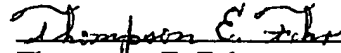


Figure 7

DATED this 1st day of June, 2005.

A handwritten signature in cursive script, reading "Thompson E. Fehr", is written over a horizontal line.

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